

29-11-02

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit:

Examiner:

Applicant: Wittwer, Bruno

Serial No: 09/831,615

Filing Date: May 10, 2001

For: PISTON PUMP

RENEWED PETITION UNDER 37 CFR §1.47(b)

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the Decision on Petition mailed 10 June 2002, Applicant hereby requests the Assistant Commissioner to reconsider the petition to treat the sole inventor as hostile for refusing to forward the executed Declaration/Power of Attorney under 37 CFR §1.63 to the office of the undersigned for eventual filing with the United States Patent and Trademark Office. Applicant also requests the non-statutory period for the response to the decision to be extended one month beyond the two-month period. Sufficient funds are enclosed herewith through authorization to charge the deposit account of the undersigned.

The facts surrounding the unsigned Declaration/Power of Attorney are as follows:

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OFFICE OF PETITIONS

1. Mr. Bruno Wittwer of 21 Southbourne Street, Scarborough, Western Australia, is the sole inventor for the above-captioned patent application.

2. Mr. Wittwer was the sole owner of a business using the registered name BW Solar.

3. Solar Energy Systems Pty Ltd (Solar Energy) purchased BW Solar in its entirety on January 22, 1999 for \$100,000 plus a royalty. The Agreement detailing the assignment of the business is attached hereto as Attachment 1.

4. The Agreement states, in part, "BW Solar Business means the solar energy and water pumping business developed by Wittwer and trading as BW Solar including, but not limited to, all patents and other intellectual property, . . . , " (paragraph 1.1 of Agreement, Attachment 1). Paragraph 6.3 thereof states "[a]ll intellectual property acquired by the Company [Solar Energy Systems Pty. Ltd.] pursuant to this Agreement and all intellectual property developed while Wittwer is an employee or consultant to the Company pursuant to this Agreement shall be and remain the property of the Company."

5. On September 9, 2002, Mr. Anthony Robert Fredrick Maslin, an officer and the Managing Director of Solar Energy, executed a declaration stating he has personal knowledge that the above-identified agreement and business deal contemplated the inclusion of the above-captioned patent application, (Attachment 2). This declaration indicates he has reviewed the patent application and that it contains no new matter from the two patent applications from which it claims its priority.

6. On June 22, 2001, Mr. Greg Allen, agent to Solar Energy Systems forwarded the patent application and declaration/power of attorney to Mr. Wittwer requesting execution of the declaration/power of attorney, (Attachment 3).

7. On July 9, 2001, Mr. Wittwer requested, inter alia, another copy of the provisional patent application, (Attachment 4).

8. On July 11, 2001, Mr. Allen forwarded the requested documentation with a cover letter and including a transmittal executed by Mr. Wittwer and the provisional patent application, (Attachment 5).

9. On July 16, 2001, Mr. Wittwer requested a retainer and fees based on an hourly rate to review the patent application, (Attachment 6).

10. On August 14, 2001, Mr. Wittwer responded to Mr. Allen's request by stating he would not sign the declaration unless he received an additional \$5,000 and permission to exercise certain stock options, (Attachment 7).

11. Mr. Wittwer's requests set forth in paragraph 9 and 10, above, extends beyond the Agreement (Attachment 1) in that the Agreement does not state additional funding and the exercise of options is allowed for Solar Energy Systems to maintain the enforceability of any rights in and to the intellectual property sold pursuant to the Agreement.

12. On December 28, 2001, Mr. Wittwer forwarded a letter to the Board of Solar Energy Systems stating he was "unsure if [Mr. Wittwer could] sign the US patent application," (Attachment 8). The enclosures to the letter, attached herewith (Attachment 8) show Mr. Wittwer's striking through all locations in the formal documents where his signature was requested.

13. On March 16, 2002, Mr. Wittwer forwarded a letter to the undersigned stating "I have not signed any assignment for execution nor an application for a patent in the United States," (Attachment 9). In this letter, Mr. Wittwer asserts a competitive position to that of Solar Energy Systems. The undersigned did not respond to this letter.

14. On April 5, 2002, Mr. Boris Golja forwarded a copy of the patent application to Wittwer on behalf of Solar Energy. The mailing included another copy of the Combined Declaration and Power of Attorney form and the Assignment. Mr. Golja received proof of delivery, (Attachment 10).

15. Confirmation of the delivery of the documents of paragraph 12, above, was made on April 8, 2002, (Attachment 11).

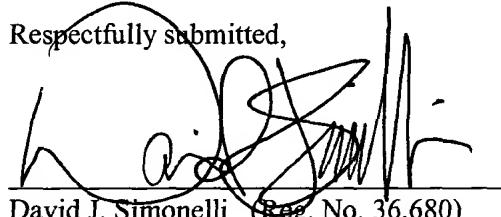
16. To date, Mr. Wittwer has not responded to the mailing set forth in paragraph 14. Applicant is not in a position to exhaust its resources to prove the negative in this matter. Applicant strongly suggests that it has sufficiently attempted to obtain Mr. Wittwer's signature and that it is not obligated to procure a signature from the hostile inventor stating he refuses to sign the declaration. Mr. Wittwer's competitive stance, his action of striking through the formal documents, and statements that he has not signed the Declaration clearly indicate that he has no intention of signing such documents. Therefore, based on the fact that Mr. Wittwer has demanded more money, desires to compete with Solar Energy Systems, and his lack of response from a registered letter sent over three months ago clearly demonstrates his refusal to sign the declaration for the above-captioned patent application.

Mr. Wittwer's address is P.O. Box 771, Scarborough, Western Australia 6922, Australia. Because Mr. Wittwer is the sole inventor, Solar Energy respectfully asserts that the granting of this petition is a necessary action to preserve the rights of Solar Energy to prevent the irreparable damage of loss of rights vis-à-vis priority to the invention disclosed in the above-captioned patent application. Applicant respectfully requests that the Assistant Commissioner accept the efforts of Applicant and allow Applicant to prosecute the patent application to its best ability as the patent application is an asset of Applicant.

Enclosed along herewith is a Power of Attorney and a newly executed Combined Declaration and Power of Attorney form executed by the undersigned on behalf of Wittwer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this Petition is directed.

The Commissioner is hereby authorized to charge the late fee of \$55.00, any overpayment or underpayment of the above fee associated with this Communication to Deposit Account No. 50-1759. A duplicate copy of this form is attached.

Respectfully submitted,

By:
David J. Simonelli (Reg. No. 36,680)
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313-965-8300

Date: 10 Sept 02
Attorney Docket No: 19724-087004